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WINSTON-SALEM NC 27101

MAILED

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OFFICE OF PETITIONS

In re Application of	:	
Rosenberg et al.	:	DECISION ON REQUEST
Application No. 10/615927	:	FOR RECONSIDERATION
Filing or 371(c) Date: 07/10/2003	:	OF PATENT TERM ADJUSTMENT
Attorney Docket Number:	:	
IMM053A	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION", filed July 30 2009. This matter is being properly treated as an application for patent term adjustment pursuant to 37 CFR 1.705(b), the application having been submitted prior to issuance of a patent. Applicants submit that the correct patent term adjustment to be indicated on the patent is 1459 days, less further reduction in connection with the amendment filed July 29, 2009, and not 1171 as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and on the basis that the adjustment is subject to further reduction of 25 days in connection with the information disclosure statement (IDS) filed November 14, 2008.

Applicants assert, based upon the holding in Wyeth et al. v Dudas, No. 07-1492 (D.C.C. September 30, 2008), that applicant is entitled to an additional delay of 313 days of USPTO delay that accrued for failing to issue the patent within three (3) years of filing.

Regarding applicant's asserted entitlement to Patent Term Adjustment ("PTA") pursuant to 37 CFR 1.705(b), as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of

issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee<sup>1</sup>.

The Determination of Patent Term Adjustment mailed May 4, 2009, indicated that the above-identified application was entitled to a PTA of 1171 days. Applicants indicate that the adjustment should be reduced an additional 25 days in connection with the IDS filed November 14, 2008.

Review of the record reveals that applicants are correct in that the Office neglected to assess a reduction of 25 days in connection with the IDS filed November 14, 2008. In accordance with 37 CFR 1.704(c)(8), the reduction commenced October 21, 2008, the day after the date the initial reply (RCE and Amendment) were filed, and ended November 14, 2008, the date that supplemental reply (IDS) was filed.

In view of the foregoing, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is 1146 days, (1187 days of PTO delay, reduced by 41 days of applicant delay), subject to any terminal disclaimer.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is 1146 days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

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<sup>1</sup> For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods at (571) 272-3232.

*/ALESIA M. BROWN/*

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Petitions Attorney  
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Office of the Deputy Commissioner  
for Patent Examination Policy

Enclosure: Adjusted PAIR Calculation

## PTA Calculations for Application: 10/615927

Application Filing Date:	07/10/2003	PTO Delay (PTO):	1187
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	16
Post-Issue Petitions:	0	Total PTA (days):	1146
PTO Delay Adjustment:	-25		

## File Contents History

Number	Date	Contents Description	PTO	APPL	START
95	11/08/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		25	
83	05/04/2009	MAIL NOTICE OF ALLOWANCE			
82	05/01/2009	ISSUE REVISION COMPLETED			
81	05/01/2009	EXAMINER'S AMENDMENT COMMUNICATION			
80	04/27/2009	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
79	04/22/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
78	04/22/2009	CASE DOCKETED TO EXAMINER IN GAU			
77	04/22/2009	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
76	04/22/2009	DOCUMENT VERIFICATION			
75	04/21/2009	NOTICE OF ALLOWABILITY			
74	02/02/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
73	03/17/2009	PARALEGAL TD ACCEPTED			
72	03/09/2009	TERMINAL DISCLAIMER FILED		0	70
71	03/16/2009	DATE FORWARDED TO EXAMINER			
70	03/09/2009	RESPONSE AFTER NON-FINAL ACTION			
69	02/02/2009	REFERENCE CAPTURE ON IDS			
68	02/02/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
67	02/02/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
66	12/09/2008	MAIL NON-FINAL REJECTION			
65	12/08/2008	NON-FINAL REJECTION			
64	11/14/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
63	11/14/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
62	10/23/2008	DATE FORWARDED TO EXAMINER			
61	10/20/2008	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
60	10/23/2008	DATE FORWARDED TO EXAMINER			
59	10/20/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)			
58	10/23/2008	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
57	10/20/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
56	03/10/2008	ELECTRONIC INFORMATION DISCLOSURE STATEMENT			

55	07/21/2008	MAIL FINAL REJECTION (PTOL - 326)			
54	06/12/2008	FINAL REJECTION			
48	03/10/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
47	05/21/2008	DATE FORWARDED TO EXAMINER			
46	03/27/2008	RESPONSE AFTER NON-FINAL ACTION		16	37
45	03/27/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
44	03/10/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
43	08/29/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
42	08/29/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
41	10/18/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
40	10/18/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
39	07/10/2003	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
38	07/10/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
37	12/11/2007	MAIL NON-FINAL REJECTION	1187		-1
36	12/10/2007	NON-FINAL REJECTION			
35	12/06/2007	PG-PUB ISSUE NOTIFICATION			
34	12/05/2007	CASE DOCKETED TO EXAMINER IN GAU			
30	11/12/2007	CASE DOCKETED TO EXAMINER IN GAU			
29	11/08/2007	CASE DOCKETED TO EXAMINER IN GAU			
28	10/17/2007	WITHDRAW FLAGGED FOR 5/25			
27	10/15/2007	FLAGGED FOR 5/25			
26	09/27/2007	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
25	10/18/2004	REFERENCE CAPTURE ON IDS			
24	10/18/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
23	07/10/2003	REFERENCE CAPTURE ON IDS			
22	07/10/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
21	07/10/2003	PRELIMINARY AMENDMENT			
20	08/30/2007	APPLICATION RETURN FROM OIPE			
19	08/30/2007	SENT TO CLASSIFICATION CONTRACTOR			
18	08/30/2007	APPLICATION IS NOW COMPLETE			
17	08/26/2006	ADDITIONAL APPLICATION FILING FEES			
16	08/16/2007	CORRESPONDENCE ADDRESS CHANGE			
14	06/23/2006	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
13	10/07/2003	PRE-EXAM OFFICE ACTION WITHDRAWN			
12	01/13/2004	PRE-EXAM OFFICE ACTION WITHDRAWN			
11	01/13/2004	APPLICATION RETURN TO OIPE			
10	01/12/2004	APPLICATION DISPATCHED FROM OIPE			
9	01/12/2004	APPLICATION IS NOW COMPLETE			
8	12/08/2003	ADDITIONAL APPLICATION FILING FEES			
7	12/08/2003	APPLICANT HAS SUBMITTED NEW DRAWINGS TO CORRECT CORRECTED PAPERS PROBLEMS			

6	10/07/2003	CORRECTED PAPER			
4	09/26/2003	CASE CLASSIFIED BY OIPE			
3	09/26/2003	CLEARED BY OIPE CSR			
2	08/22/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	07/10/2003	INITIAL EXAM TEAM NN			

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#### EXPLANATION OF PTA CALCULATION

#### EXPLANATION OF PTE CALCULATION

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